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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,760	06/07/2001	Markus Scheuber	34183/233887	2221

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EXAMINER
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CULLER, JILL E

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/876,760

Applicant(s)

SCHEUBER ET AL.

Examiner

Jill E. Culler

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event; however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06/07/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 2 and 5-14 are objected to because of the following informalities:

In claim 2, line 3, "the step of" is redundant.

In claim 5, line 5, the word "and" appears to be unnecessary.

In claim 8, line 5, the word "and" appears to be unnecessary.

In claim 11, line 6, the word "and" appears to be unnecessary.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,505,497 to Katzman.

Katzman shows a method of providing text on a printed surface of a printed product comprising the steps of applying a contrast panel to the printed surface by printing the contrast panel onto the printed surface, see column 1, lines 42-46, and forming information within or on the contrast panel, with the contrast panel forming a contrast with respect to the information so that the information can be easily seen and read, wherein the step of forming information within or on the contrast panel comprises

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printing the information onto the contrast panel. See column 1, lines 50. Katzman also teaches the step of forming information within or on the contrast panel comprising forming blank areas within the contrast panel, with the blank areas forming the information. See column 3, lines 45-53.

4. Claims 1-2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,084,026 to Gurwick.

Gurwick teaches a method of providing text on a printed surface of a printed product comprising the steps of applying a contrast panel to the printed surface by printing the contrast panel onto the printed surface, see page 2, lines 65-70, and forming information within or on the contrast panel, with the contrast panel forming a contrast with respect to the information so that the information can be easily seen and read, wherein the step of forming information within or on the contrast panel comprises printing the information onto the contrast panel. See page 2, line 70 - page 3, line 1. Gurwick further teaches that the contrast panel is partially transparent. See page 2, lines 11-15.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5-7 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katzman in view of U.S. Patent No. 4,983,990 to Fröhlich.

Katzman teaches all that is claimed, as in the above rejection of claims 1-3 except for providing text on each of a plurality of printed products by conveying the printed products along a path of travel in an overlapping imbricated stream such that a border region of each printed product is exposed by the imbricated overlap as each printed product passes printing stations along the path of travel.

Fröhlich teaches providing text on each of a plurality of printed products by conveying the printed products along a path of travel in an overlapping imbricated stream, see column 2, lines 55-59, such that a border region of each printed product is exposed by the imbricated overlap as each printed product passes printing stations along the path of travel. See column 3, lines 55-57.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the printing steps of Katzman with the printing method of Fröhlich in order to provide text on the borders of a plurality of printed articles in an efficient, automated manner.

7. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katzman in view of Fröhlich as applied to claims 5-7 and 11-13 above, and further in view of Gurwick.

Katzman and Fröhlich teach all that is claimed, as in the above rejection of claims 5-7 and 11-13 except that the printed contrast panel is partially transparent.

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Gurwick teaches a contrast panel that is partially transparent.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the partially transparent contrast panel with the printing method of Katzman and Fröhlich in order to be able to see part of the original printed matter through the contrast panel.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katzman in view of Fröhlich as applied to claims 5-7 and 11-13 above, and further in view of U.S. Patent No. 4,538,161 to Reist.

Katzman and Fröhlich teach all that is claimed, as in the above rejection of claims 5-7 and 11-13 except that the conveyor system comprises a plurality of clamps arranged one behind the other in the conveying direction for gripping respective ones of the printed products.

Reist teaches a conveyor system, 11, comprising a plurality of clamps, 13, arranged one behind the other in the conveying direction for gripping respective ones of printed products.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the conveyor system of Reist with the invention of Katzman and Fröhlich in order to move the printed products through the printing process in a well-controlled manner.

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***Conclusion***


9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 3,149,711 to Wolowitz, U.S. Patent No. 3,282,720 to Oleksiw and U.S. Patent No. 5,933,578 to Van de Capelle et al. each teach a method and apparatus for providing text on a printed surface of a printed product having obvious similarities to the claimed subject matter.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill E. Culler whose telephone number is (703) 308-1413. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (703) 305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

jec  
February 23, 2003

  
**ANDREW H. HIRSHFELD**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2800**